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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/927,176

08/10/2001

Scott K. Strenk

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4641

33461

7590

03/26/2004

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EXAMINER

MAI, HUY KIM

ART UNIT

PAPER NUMBER

2873

DATE MAILED: 03/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/927,176

Applicant(s)

STRENK, SCOTT K.

Examiner

Huy K. Mai

Art Unit

2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Aug. 10, 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received. .

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on Oct. 2, 2003 has been entered.
2. The advisory action mailed Nov. 12, 2003 has been withdrawn because of the request continued examination under 37 CFR 1.114.
3. The examiner thanks the applicant for the patience during the transition from the paper file to IFW to process the RCE and the amendment under 37 CFR 1.116. The delayed processing is also caused by the wrong code in scanning the RCE.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al (6,375,321) in view of Zelman (6,342,858).

Lee et al discloses in Fig. 7, column 4, lines 42-45 and column 7, lines 1-20, an eyewear assembly comprising primary eyeglasses and auxiliary eyeglasses that are attachable by catch-and-click mating engagement and detachable from each other

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wherein the primary frame including first and second recessed sockets 300 each provided with respective metallic, non-magnetized bottom and side walls, the side walls being oriented substantially vertical when the primary eyeglasses are worn on the human face; and the auxiliary arms 202 each having a respective magnet 301 permanently affixed thereto, the magnets having protruding portions sized and configured to be received into corresponding ones of the sockets and to magnetically attract the metallic, non-magnetized bottom and side walls of the sockets to permit catch-and-click mating engagement of the magnets with the sockets. However, the sockets each have a respective opening facing upward instead of facing downward as claimed by the applicant. The feature “the sockets each have a respective opening facing upward” in Lee et al’s device imply that the auxiliary eyeglasses detachably attached to the primary eyeglasses from above instead of detachably attached to the primary eyeglasses from below as claimed by the applicant.

Zelman discloses the auxiliary eyeglasses detachably attached to the primary eyeglasses from below.

Since Lee et al and Zelman are both from the same filed of endeavor, the purpose disclosed by Zelman would have been recognized in the pertinent art of Lee et al.

It would have been obvious at the time the invention was made to a person having skill in the art to modify the catch-and-click mating engagement in the Lee et al’s eyewear assembly in light of Zelman’s teachings by forming the sockets each have a respective opening facing downward for the purpose of detachably attaching auxiliary eyeglasses to primary eyeglasses as disclosed by Zelman.

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Regarding claim 10, the structure of an eyewear assembly in claim 10 is similar to that of an eyewear assembly in claim 9, except for rearranged the catch-and-click mating engagement by forming the sockets on the arms of the auxiliary eyeglasses and forming the magnets having protruding portions on the temple mounts. Lee et al suggests in column 7, lines 8-10 “two corresponding member of the receiving member 300 and inserting member 301 can be substituted with each other”. Thus with the Lee et al’s suggestion would have been motivated to modify the catch-and-click mating engagement in the Lee et al in view of Zelman’s eyewear assembly by forming the sockets on the arms of the auxiliary eyeglasses and forming the magnets having protruding portions on the temple mounts for the same purpose of detachably attaching auxiliary eyeglasses to primary eyeglasses as disclosed by Lee et al and Zelman as same as the applicant does.

Furthermore, the quotation of 35 USC 103(a) states: “Patentability shall not be negated by the manner in which the invention was made”. Thus the invention with the rearrangement of the catch-and-click mating engagement by forming the sockets on the arms of the auxiliary eyeglasses and forming the magnets having protruding portions on the temple mounts would not patentable distinct from the Lee et al in view of Zelman’s eyewear assembly as discussed above under the quotation of 35 USC 103(a).

#### ***Response to Arguments***

6. Applicant's arguments with respect to claims 2-17 have been considered but are moot in view of the new ground(s) of rejection.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy Mai whose telephone number is (571) 272-2334. The examiner can normally be reached on M-F (8:00 a.m.-4:30 p.m.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached on (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1562.



Huy Mai  
Primary Examiner  
Art Unit 2873

HKM/  
March 18, 2004